

## **REMARKS**

After entry of the instant Amendment, claims 5, 6, 8-10, and 17, 19, and 20-30 are pending in the instant application. Claims 6 and 19 are cancelled in this Amendment. Claims 1-4, 7, and 11-16 were previously cancelled. Claim 5 is amended to remove the process step of treating the surface of the silver-based powder via a chemical reaction. Accordingly, claims 9 and 18 are herein amended for clarity. Claim 30 is added and represents now-cancelled claim 6 that is simply rewritten as a method claim depending from the method of claim 20. No new matter is added in this Amendment.

### **Claims Indicated as Allowable:**

The Examiner has indicated that claims 20-29 are not subject to any rejections and are found to be allowable. The Applicant thanks the Examiner and accepts these allowed claims.

### **Claim Rejections Under 35 U.S.C. §103:**

The Examiner maintains that claims 5, 6, 8-10, and 17-19 remain rejected as obvious over Fujiki et al. (U.S. Pat. No. 6,140,446). Although the Examiner admits that Fujiki “does not explicitly teach that the silver filler and the benzotriazole undergo a chemical reaction,” the Examiner interprets independent claim 5 (prior to the instant Amendment) as a product-by-process claim and thus maintains the obviousness rejection. Relative to product-by-process claims, the Patent Office typically bears a lesser burden of proof in establishing a proper *prima facie* case of obviousness (see MPEP §2113).

The Applicant has amended claim 5 to remove the active step of treating the surface of the silver-based powder via a chemical reaction. In so doing, the Applicant positively recites the structure of the silver based powder by clarifying that the silver-based powder has a surface and comprises a chemical reaction product of the oxidation inhibitor that is a triazole-based

compound and the surface. This amendment clarifies makes it clear that independent claim 5 is not a product-by-process claim and instead is an article type claim.

To properly reject amended claim 5 as obvious, the lesser burden of proof associated with product-by-process claims is no longer applicable. Instead, the Patent Office must now demonstrate that the prior art discloses, teaches, or suggests each and every element of this claim. Since the Examiner has already concluded on the record that Fujiki “does not explicitly teach that the silver filler and the benzotriazole undergo a chemical reaction,” it is clear that amended claim 5 is novel, non-obvious, and patentable over the prior art.

### **Conclusion**

Claim 5, as amended, is not a product-by-process claim. Accordingly, the Examiner’s obviousness rejection based on Fujiki no longer applies. Quite simply, Fujiki does not disclose, teach, or suggest each and every element of this claim. Thus, claim 5, and claims 6, 8-10, and 17, 19 which depend from claim 5, are both novel and non-obvious. Accordingly, the Applicant respectfully requests that all obviousness rejections be withdrawn and that all claims be allowed.

Although no fees are believed to be due at this time, the Commissioner is authorized to charge Deposit Account No. 08-2789 in the name of Howard & Howard Attorneys PLLC for any fees or credit the account for any overpayment for this matter.

Respectfully submitted,

**HOWARD & HOWARD ATTORNEYS PLLC**

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Date

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